

ESTTA Tracking number: **ESTTA237980**

Filing date: **09/19/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Subterra, Inc.
Granted to Date of previous extension	09/21/2008
Address	218 East North Bend Way North Bend, WA 98045 UNITED STATES
Attorney information	Scott G. Warner and Jennifer Krebs Garvey Schubert Barer 1191 2nd Ave., 18th Floor Seattle, WA 98101 UNITED STATES jdelo@gsblaw.com Phone:206-464-3939

### Applicant Information

Application No	77290414	Publication date	03/25/2008
Opposition Filing Date	09/19/2008	Opposition Period Ends	09/21/2008
Applicant	Subterracom Wireless Solutions, LLC Suite 1202 2 Tower Center East Brunswick, NJ 08816 UNITED STATES		

### Goods/Services Affected by Opposition

Class 009. First Use: 2007/07/01 First Use In Commerce: 2007/07/01  
All goods and services in the class are opposed, namely: Computer enterprise software providing interface link between wireless network, location and communication devices and dispatch/control operations for tracking, monitoring and communicating by voice and text with miners underground

### Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

### Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2131719	Application Date	02/05/1996
Registration Date	01/27/1998	Foreign Priority Date	NONE
Word Mark	SUBTERRA, INC.		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1991/07/20 First Use In Commerce: 1991/07/20 civil engineering services; mining engineering services; geotechnical engineering services; environmental engineering services; slope, terrain and geotechnics stability services; waste management services; and consultation services, therefor, for all of the above

Related Proceedings	91186389
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Attachments	SubterraVU opposition.pdf ( 6 pages )(30978 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/JAK/
Name	Scott G. Warner and Jennifer Krebs
Date	09/19/2008

IN THE UNITED STATES PATENT AND  
TRADEMARK OFFICE BEFORE THE TRADEMARK  
TRIAL AND APPEAL BOARD

SubTerra, Inc.

Opposer,

vs.

Subterracom Wireless Solutions, LLC

Applicant.

NOTICE OF OPPOSITION

Opposition No. \_\_\_\_\_

In re matter of Application Serial No: 77290414

Filed: September 27, 2007

Trademark: SUBTERRA-VU

Published: March 25, 2008

Box TTAB Fee  
Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

NOTICE OF OPPOSITION

To Whom It May Concern:

SubTerra, Inc., a Washington corporation with its principal place of business at 218 East North Bend Way, North Bend, Washington 98045 ("SubTerra"), believes that it is or will be damaged by registration of the mark shown in application Serial No. 77290414, filed on September 27, 2007 and published on March 25, 2008. SubTerra will be harmed if the registration is issued because (1) the Applicant is incorporating the

dominant feature of SubTerra's registered trademark into its proposed application, (2) the two companies serve the same industry, and (3) sell related products, registration is sure to lead to consumer confusion. The Application was Published for Opposition on March 25, 2008. Requests for Extension of Time to Oppose were filed on March 25, 2008 and July 23, 2008.

As grounds for opposition, it is alleged that:

SubTerra used the "SUBTERRA, INC." mark prior to Applicant's use

1. Commencing in 1991 and continuing to the present, Opposer SubTerra, Inc., a Washington corporation ("SubTerra"), has provided a variety of products and services to the underground and mining industries, including mining, civil, geotechnical and environmental engineering; geotechnical instrumentation and data acquisition (including wireless transmission of data); construction planning and management; and construction and blast vibration monitoring (including equipment rental and sales, remote data acquisition and monitoring using wireless and cellular technology and the internet).

2. Opposer SubTerra has used its Mark SUBTERRA, INC. (the "Mark") continually in interstate commerce since July 20, 1991 to sell its goods and services.

3. On February 5, 1996, Opposer filed an application in the U.S. Patent and Trademark Office, serial number 75053235, seeking registration on the Principal Register of the mark SUBTERRA, INC. for various services in International Class 42. This application matured into registration number 2,131,719 on January 27, 1998 for:

civil engineering services; mining engineering services;  
geotechnical engineering services; environmental  
engineering services; slope, terrain and geotechnics  
stability services; waste management services; and  
consultation services, therefor, for all of the above, in Class  
42.

4. Opposer has filed all necessary renewals and has continuously used its Mark in interstate commerce since that time.

5. SubTerra has also used its Mark as part of its domain name since 1996. Its current domain name is [www.subterra.us](http://www.subterra.us), which has been registered since 2003. Prior to that, SubTerra used its Mark as part of several domain names (“subterra-inc.com” since 1996; “subterra.biz” since 2001; and “subterra.info” since 2001); these domains remain active and now point to [www.subterra.us](http://www.subterra.us).

6. Opposer has offered services under its Mark throughout the United States, and has invested considerable sums and effort in developing valuable goodwill in its Mark.

7. On or about September 27, 2007, Applicant Subterracom Wireless Solutions, LLC, a Delaware limited liability company (“Applicant”), filed the above-referenced application, based on its intent to use Applicant’s Mark, with the U.S. Patent and Trademark Office, seeking registration on the Principal Register of the mark SUBTERRA-VU (“Applicant’s Mark”) for goods and services in International Class 9, specifically:

Computer enterprise software providing interface link between wireless network, location and communication devices and dispatch/control operations for tracking, monitoring and communicating by voice and text with miners underground.

8. There is no issue as to priority. Applicant’s application is based on its intent to use Applicant’s Mark and application for registration of Applicant’s Mark was filed subsequent to the date of Opposer’s first use in commerce and registration of its SUBTERRA, INC. mark.

9. Applicant's Mark SUBTERRA-VU is strikingly similar in sight and commercial impression to Opposer's Mark SUBTERRA, INC., and is actually being used in a manner that highlights the SubTerra Mark. Further, Applicant apparently intends to use its SUBTERRA-VU mark for a similar purpose as Opposer is currently using its Mark, i.e., communications devices for underground applications, and in the same channels of trade and geographic extent (worldwide). Such use suggests that the actual source of these products is SubTerra.

10. Opposer will be damaged by Applicant's proposed registration because Applicant's Mark is confusingly similar to Opposer's Mark. The dominant portion of Applicant's Mark incorporates the term "SUBTERRA", which is the core of Opposer's Mark, and when applied to underground products, Applicant's Mark is likely to be confused with the underground products and services offered by Opposer, so as to cause confusion and lead to deception as to the origin of the products bearing Applicant's Mark.

11. If Applicant is permitted to use and register Applicant's Mark, confusion in trade resulting in damage and injury to Opposer will result. Persons familiar with Opposer's Mark and the products and services offered by Opposer under its Mark would be likely to buy Applicant's products mistaking them for those offered and sold by the Opposer, and any defect or fault in Applicant's goods would reflect upon Opposer and injure the reputation and goodwill Opposer has established for its products and services under its Mark. Hence, the potential for confusion is very great, and registration of Applicant's Mark should be denied.

WHEREFORE, Opposer SubTerra requests this Opposition be sustained and that the registration sought in Trademark Application Serial No.: 77290414 be denied.

Respectfully submitted,  
GARVEY SCHUBERT BARER

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By: /Jennifer Amanda Krebs/  
Jennifer Amanda Krebs, WSBA #35372  
Scott Warner, WSBA #12873

Dated: September 19, 2008  
Seattle, Washington

## CERTIFICATE OF MAILING

Pursuant to Rules of Practice in Trademark Cases 2.101(a) and (b), and 2.119(4) & (5), 37 C.F.R. §§ 2.101(a) and (b) and 2.119(4) & (5) (2007), I hereby certify that a true, correct and complete copy of the foregoing Notice of Opposition has been served on counsel of record for the Applicant, P. Jay Hines, Esq., by sending a copy of the same, on the 19th of September, 2008, via First Class Mail, postage prepaid, to Applicant's correspondence address of record in the Office, namely:

P. Jay Hines  
Cantor Colburn LLP  
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/Jennifer Amanda Krebs/  
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Title: Attorney for Opposer

Dated: September 19, 2008  
Seattle, Washington